

## **REMARKS/ARGUMENTS**

Claims 1-8 are presently pending in the application as set forth in the Amendment A filed May 18, 2005..

In this amendment, Claims 1 and 8 have been amended.

Claims 9-12 have been added.

Claims 2, 3, 6, 7 remain unchanged.

Claims 4, 5 have been withdrawn and also remain unchanged.

Applicant notes that, per the Advisory Notice of September 21, 2005, the Amendment B filed on September 9, 2005 was not entered. Hence, this amendment amends the claims from the form set forth in Amendment A.

As set forth below, the amendments to the Claims are believed to place the Claims in condition for allowance. In view of the amendments, as discussed below, reconsideration of the Application and issuance of a Notice of Allowability are respectfully requested.

### **Amendment To Title**

Initially, Applicant notes that the title of the application has been changed from "Copper Colored Jewelry And Method Of Manufacturing Copper Colored Jewelry" to "Shakudo Jewelry". This amendment was made to better describe the invention. As is apparent from the application, the invention is not to "copper colored jewelry" per se, but rather to Shakodu Jewelry. Shakodu is a specific type gold-copper alloy. This

amendment to the title does not add new matter to the application, and entry of the amendment to the title is respectfully requested.

### **Applicant's Invention**

As noted in the prior amendment, Applicant has found a solution to two problems with Shakodu Jewelry: (1) the securing of a gold-copper alloy decoration in an inlay area of the ring (or other item of jewelry) to prevent the decoration from protruding from the jewelry and (2) providing a gold-copper alloy that, once tarnished from oxidation, can be polished to recover the original color of the decoration.

### **HISTORY OF SHAKUDO**

Shakudo is the Japanese term for a low gold content smelted alloy which, as set forth in the application, usually consists of between 0.5% and 5% 24k gold, the remainder being copper. (See Par. [0002] of the application). This traditional Shakudo alloy, which is comprised mainly of copper, obtains a durable but unpredictable, swirling-patterned or blotched, purplish black surface color when it naturally oxidizes or when treated with a suitable oxidizing solution.

The first known use of this alloy was in cast form during the 6th century Han Dynasty in China. The discovery and initial development of the alloy was most likely a result of accidental smelting of gold bearing copper ores.

Although the resulting alloy was considered beautiful, it was quickly abandoned by the Chinese because of wildly varying coloring variations and the inability of craftsmen to

consistently and uniformly replicate a desirable color from which to mass produce the alloy for use in jewelry and home furnishings.

Centuries later, the abandoned Shakudo alloy was rediscovered by Japanese craftsmen visiting China, refined and used, in wrought form mainly, for decorations and fashion accessories. The alloy was frequently used as a base for gold inlay on Japanese swords as well as hair clasp and combs.

The purple-black patina makes a very striking background contrast to gold, but ultimately even the refined Japanese version of the Shakudo alloy became unpopular with clientele because of the continuing inability of craftsmen to consistently and uniformly replicate a desirable color and patterning to mass produce the alloy.

#### APPLICANT'S UNIQUE SMELTING AND PATINATION TECHNIQUES

Applicant's present unique smelting and patina techniques allow for highly consistent and reliable color saturations and uniform, non-patterned, non-swirling, non-blotched appearance of color of the Shakudo alloy during the oxidation process, regardless of whether Applicant's alloy naturally oxidizes or is treated with a suitable oxidizing solution.

Additionally, due to the precise and unique percentages copper and gold combined in Applicant's smelting process and patination techniques the present Shakudo alloy, when highly polished, appears to the untrained eye to be natural gold. As noted above, and in the application, the traditional Shakudo alloy contains up to 5% gold, the remainder

being copper. Applicant, on the other hand, as reversed the percentages, and Applicant's claimed alloy contains 85-94% gold. Hence, Applicant's Shakudo alloy contains many times the amount of gold contained in traditional Shakudo alloys.

Since Applicant's alloy initially appears to be natural gold, if the alloy is inlaid into a gold ring setting and is highly polished it becomes undetectable to the untrained eye. However, as Applicant's Shakudo alloy slowly oxidizes over time (2 to 3 months) it "mysteriously" appears from the natural gold setting in whatever shape or pattern that is inlaid into the setting. To the wearer, it's as if the inlaid pattern appears from the gold setting by magic.

The gradually increasing visual contrast of Applicant's oxidizing Shakudo alloy in relation to the gold setting is striking and color gradations and color saturations levels of the Applicant's Shakudo alloy are uniform, non-patterned, non-swirling, and non-blotched. They are always consistent and always predictable. By polishing the jewelry, Applicant's Shakudo alloy can be returned to its original gold color, to be indistinguishable from the item of jewelry in which the alloy is set, allowing the wearer to again wait and watch for the design of the alloy to appear as it oxidizes.

### **Rejection Under 35 U.S.C. §102**

The Examiner has continued his rejection of the Claims 1-3 and 6-8 under 35 U.S.C. §102(b) as being anticipated by West (Pat. No. 6062045).

Initially, and as discussed in the prior amendment, West was solving a substantially different problem than Applicant is solving in his present invention. As set forth at Col. 8, lines 17-24, West was solving the problem of providing highly wear resistant jewelry. As set forth thereat:

“The principal concept of this invention is the provision of an ultra durable hard metal or high tech ceramic type of jewelry that may or may not incorporate precious metals and/or precious gem stones. The invention also provides a unique jewelry manufacturing process that combines hard metals with precious metals in a manner such that the precious metals are flush or recessed slightly below the outer most surfaces of the hard metals over the outer wear surfaces to achieve maximum abrasion and corrosion resistance.”

To this end, West, in FIG. 5 shows a band of precious metal being received in a groove in a ring. Applicant, on the other hand and as noted above, is solving a substantially different problem which is not solved by West – namely, (1) the securing of a copper alloy decoration in an inlay area of the ring (or other item of jewelry) to prevent the decoration from protruding from the jewelry and (2) providing a copper alloy that, once tarnished from oxidation, can be polished to recover the original color of the decoration. Applicant notes that Claim 1 has been amended to be in Jepson format to make clear that the alloy set forth in the claim is part of the inventive aspect of the invention.

To anticipate Applicant's claimed invention, “the identical invention must be shown in as complete detail as is contained in the ... claim”. MPEP §2131, *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Hence, West must show each and

every feature set forth in the rejected claim. However, West does not teach the copper alloy set forth in Claim 1.

The Examiner states that West's assertion that "a selected precious metal and/or other forms of material" which can be inlaid in the groove provides support for the anticipatory rejection of Claim 1. While West discloses that various materials may be used in the groove, West does not teach or suggest the *claimed alloy* as set forth in Claim 1, namely, an alloy "composed of 6 to 15 weight percent copper and 94 to 85 weight percent gold". Because West does not disclose the claimed alloy, West cannot anticipate Claim 1 as currently set forth.

What the Examiner has done, in effect, is reject a species with a genus. However, as set forth in MPEP 2131.02, this is not proper. MPEP 2131.02 states that "a genus does not always anticipate a claim to a species within the genus." MPEP 2131.02 goes on to state that:

"When the compound is not specifically named [in the reference], but instead it is necessary to select portions of teachings within a reference and combine them, e.g., select various substituents from a list of alternatives given for placement at specific sites on a generic chemical formula to arrive at a specific composition, anticipation can only be found if the classes of substituents are sufficiently limited or well delineated. *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990). If one of ordinary skill in the art is able to "at once envisage" the specific compound within the generic chemical formula, the compound is anticipated. One of ordinary skill in the art must be able to draw the structural formula or write the name of each of the compounds included in the generic formula before any of the compounds can be "at once envisaged." One may look to the preferred embodiments to determine which compounds can be anticipated. *In re Petering*, 301 F.2d 676, 133 USPQ 275 (CCPA 1962)" (emphasis added)

However, West's mere recitation that "other forms of material" can be used does not contain a description which would sufficiently limit or delineate the copper alloy as set forth in Claim 1. Hence, the copper alloy set forth in Claim 1 cannot "be at once envisaged" by one of ordinary skill in the art based on the teachings of West. Thus, Applicant respectfully points out that West does not anticipate Claim 1 or the claims which depend therefrom.

In his "response to arguments", the Examiner notes that "the purpose of an invention of the prior art is irrelevant so long as the structure maintains as being anticipatory." As noted above, Applicant, in Claim 1, is now claiming that the improvement comprises the alloy. Applicant respectfully asserts that this amendment to Claim 1 moots the Examiner's comments regarding structure. Further Applicant notes that the Examiner has conceded that West does not teach the claimed copper alloy. For this additional reason, Applicant respectfully asserts that West does not anticipate Claim 1.

Because West does not teach the claimed alloy composition, West, as noted cannot anticipate Claim 1. Thus, at best, West can be used to support a rejection of Claim 1 under §103. However, West does not make the claimed invention obvious. In addressing the alloy composition, the Examiner states:

"It would also be readily understood and appreciated by those of ordinary skill in the art, of the known aptitude to combine varying percentages of different metals for purposes of obtaining different color schemes, and utilizing the different physical properties of each metal

individually as well as the result combined, such as corrosion and hardness characteristics of a jewelry item”.

This statement by the Examiner amounts to an “obvious to try” rejection of the alloy set forth in the claim. As set forth in MPEP §2145.X.B, an “obvious to try” rejection is improper without some suggestion to modify the prior art. Here, the Examiner has not provided any suggestion or motivation to modify the teachings of West to use Applicant’s alloy. Without any suggestion as to the desirability to use the alloy set forth in Claim 1, West cannot make obvious the invention of Claim 1.

Further, as noted above, West solves a substantially different problem than Applicant. As set out in the excerpt above from West, West was solving the problem of providing an ultra durable hard metal or high tech ceramic type of jewelry. That is, West was providing the material from which a ring, pendant, etc. can be made. Applicant, on the other hand, is providing an alloy for use in decorating jewelry that has unique color characteristics, as set forth at page 2 of the substitute specification. Thus, the West reference is in a different field from Applicant’s endeavor. Although the West reference is in a different field, it could still be analogous prior art if it would be reasonably pertinent to the particular problem with which the inventor was concerned. To be pertinent, the reference must be one which logically would have commended itself to an inventor’s attention in considering his problem. MPEP §2141.01(a) and cases cited therein. One trying to produce an alloy for jewelry inserts or decorations with particular color characteristics would not logically be expected to examine art related to the strength of the



alloy used for making jewelry. Applicant thus respectfully asserts that West is non-analogous prior art and respectfully requests that it be removed as prior art. MPEP §2141.01(a).

For at least the forgoing reasons, Claim 1 is believed to be allowable over the West patent. Claims 2-3, 6 and 7 depend from Claim 1 and are similarly believed to be allowable.

At page 7 of the office action, the Examiner recommended focusing on the structure of the jewelry. Claim 8 has thus been amended to further describe the structure of the inlay area which receives the decorating part. Applicant also points out that some of the "product by process" elements that were originally set forth in Claim 8 have been removed. Claims 9-12 have been added to further describe the structure of the inlay area. The structure of the inlay area as described in FIGS. 8-12 is shown in FIG. 2A of the application. Hence, the amendment to Claim 8 and the insertion of new Claims 9-12 do not add new matter to the application.

None of the references, whether considered individually or in combination teach or suggest the item of jewelry as set forth in Claim 8. In particular, none teach a piece of jewelry with an inlay area having the shape or structure as set forth in Claims 8-12. Hence Claims 8-12 are believed to be allowable over the art of record.

Appl. No. 10/708,392  
Amdt. dated January 4, 2006  
Reply to Office action of July 11, 2005

In view of the foregoing, Claims 1-3 and 6-12 are believed to be in condition for allowance. A Notice of Allowability with respect to these claims is thus respectfully requested.

Respectfully Submitted,

Dated: 1/4/06

  
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